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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------|------------------|
| 10/532,058 | 05/19/2005 | Bo Haggman | TPP 31760 | 4273 |
| 24257 | 7590 | 03/15/2006 | EXAMINER | |
| STEVENS DAVIS MILLER & MOSHER, LLP 1615 L STREET, NW SUITE 850 WASHINGTON, DC 20036 | | | NILAND, PATRICK DENNIS | |
| | | ART UNIT | | PAPER NUMBER |
| | | 1714 | | |

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|--------------------------------------|-------------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/532,058 | HAGGMAN ET AL. |
| | Examiner Patrick D. Niland | Art Unit 1714 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 1-16 is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>4/05</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: ____ . |

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1. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The instant claims 1-3 recite "obtainable". Given the lack of specificity regarding what polymerizations actually make and the resultant uncertainty regarding the exact identity of the resulting product, it would require undue experimentation to determine all of the products made by all of the other possible processes that make compositions falling within the scope of those of the instant claims due to the uncertainty introduced into the claims by "obtainable". "Obtained" is acceptable.

The following are supporting decisions for rejecting "obtainable" and similar terms as indefinite.

1. Atlantic Thermoplastics Co. Inc. v Faytex Corp. 23 USPQ 2nd 1481 (1486).

In footnote 6, on page 1486, referring to Cochrane v Badische Aniline and Soda Fabrik (BASF), 11 US 293, the court stated "...because artificial alizarine can take different forms, BASF's claim would be indefinite unless limited to the described process".

The claim referred to is

"Artificial alizarine produced from anthracene or its derivatives by either of the methods described herein or any other method producing a like result."

2. Ex parte Tanksley 26 USPQ 2nd 1389

"A claim is indefinite if undue experimentation is involved to determine boundaries of protection".

This rationale is applicable to polymers obtainable by a stated process because any variation in any parameter within the scope of the claimed process would change the polymer produced. One who made or used a polymer made by a process other than the process recited in the claim would have to produce polymers using all possible parameters within the scope of the claims (temperature, pressure, diluents, component ratios, feed ratios, etc.) and then extensively analyze each product, to determine if his polymer was obtainable by a process within the claimed process.

3. Purdue Research v Watson 1959 CD 124 (Dist Ct) affirmed by CCPA 120 USPQ 521.

"Preparable by" was held to not particularly point out and distinctly claim the invention.

"When one has produced a composition of matter where it is not possible to define its characteristics which make it inventive except by reference to the process by which it is produced, one is permitted to so claim the composition produced by the process referred to in the claims. When the composition is thus claimed in terms of the process of its preparation, the product cannot be defined in such a manner as to assert a monopoly on the product by whatever means produced.

B. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is

(a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 1, 6, 9, 10, 12, 13, 14, and 15 recite the broad recitations followed by narrow recitations denoted by “such as”.

C. It is unclear what type of molecular weight is intended by the instant claim 4. The polymer molecular weights are known to be average molecular weights, e.g. number, weight, z, viscosity, etc. average molecular weights. A polydispersity of exactly one is not disclosed and is not believed to have ever been made.

D. It is unclear what the percentage of the instant claim 11 is based on, e.g. weight, volume, moles, or some other basis.

E. Claims 15-16 provide for the use of the polymer of claim 1, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 15-16 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd. App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

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2. Claims 1-14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

US Pat. No. 5418301 Hult et al. and WO 02/32982 Overbeek et al. are representative of the closest prior art but do not teach nor make obvious the instantly claimed inventions.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick D. Niland
Primary Examiner
Art Unit 1714